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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,696	08/02/2005	Gerhard Schinzel-Reiner	2732-160	8531

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WASHINGTON, DC 20005

EXAMINER

CICCHINO, PATRICK D

ART UNIT

PAPER NUMBER

3653

NOTIFICATION DATE

DELIVERY MODE

02/12/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary**Application No.**

10/523,696

Applicant(s)

SCHINZEL-REINER ET AL.

Examiner

Patrick Cicchino

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is a response to the applicant's amendment dated 11/18/2008 where claims 1-14 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification doesn't clearly disclose aligning the bank note while it is being transported in the transport direction (i.e. new matter).

Claim 1 recites the limitation "the alignment" in line 3 and "the presence" in line 5. Claim 3 recites the limitation "the alignment" in line 3 and "the presence" in line 6. There is insufficient antecedent basis for this limitation in these claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-7 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Gerlier (US Pat No 5,140,166).

Regarding claim 1, Gerlier discloses the use of detecting the alignment of a sheet (24) transported separately in a transport system (i.e. shown in figure 4), checking the detected alignment of the sheet as to a presence of misalignment, aligning the sheet in a desired alignment by a movement of the single banknote in a direction deviating from the transport direction of the transport system using the detected misalignment, detecting the alignment of the sheet during the aligning, aligning while the sheet to be aligned is transported in the transport direction and terminating the aligning as soon as the sheet has the desired alignment (as disclosed in figures 2-4, and 6, column 4, lines 30-39 and column 5, lines 51-66).

Regarding claim 3, Gerlier discloses a device for detecting an alignment (29) of a sheet transported separately in a transport system, a device for checking the detected alignment (i.e. 20) of the sheet as to the presence of a misalignment, the misalignment being a movement of the sheet in a direction deviating from the direction of the transport system, means for aligning (i.e. 2-5) the sheet in a desired alignment, the means controlled by a device for checking the detected alignment (i.e. 20) using the detected misalignment while the bank note to be aligned is being transported in the transport direction, the device detecting the alignment detects the alignment of a single sheet in the area of the means for aligning and the device for checking the detected alignment stops the means for aligning as soon as the single sheet has the desired alignment (as shown in figures 2-4, and column 4, lines 30-39 and column 5, lines 61-66).

Claims 4-7 and 13 are rejected as stated in the office action dated 12/31/2007.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 10, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerlier in view of Ek (US Pat No 5,755,437).

Claims 2, 10, 11 and 14 are rejected as stated in the office action dated 12/31/2007.

Claims 8, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerlier in view of Craft (US Pat No 3,918,706).

Claims 8, 9, and 13 are rejected as stated in the office action dated 12/31/2007.

Response to Arguments

Applicant's arguments filed 11/18/2008 have been fully considered but they are not persuasive.

Regarding the applicant's argument that Gerlier fails to disclose that the detection of the misalignment during the aligning and the aligning occurring while the bank note to be aligned is being transported in the transport direction; Gerlier discloses the alignment device to transport the document in the transport direction during alignment, wherein the difference in angular displacement of the rollers comes from a braking system to slow or stop a respective roller to achieve alignment, and the sheet to be aligned is in the aligning mechanism (as disclosed in

column 4, lines 30-47). As shown in figure 6, and disclosed in column 8, line 64 through column 9, line 68).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Cicchino whose telephone number is (571)270-1954. The examiner can normally be reached on Monday-Friday, 8:00-5:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. C./
Examiner, Art Unit 3653

/Patrick H. Mackey/
Supervisory Patent Examiner, Art Unit
3653

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